

Appln. No. 10/657,044
Amendment dated March 22, 2005
Reply to Office Action mailed December 23, 2004

Amendments to the Drawings

The attached sheets of drawings includes changes to Figs. 1 through 3. These sheets, which include Fig. 1 through 3, replace the original sheets including Figs. 1 through 3

Attachment: Replacement Sheets

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REMARKS

Reconsideration is respectfully requested.

Claims 1 through 7 and 9 through 12 remain in this application. Claim 8 has been cancelled. Claim 13 has been added.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Paragraph 1 of the Office Action

The drawings have been objected to.

Submitted under separate cover and addressed to the Examiner is applicant's proposed amendment of the drawing. Specifically, in Figures 1 through 3 of the drawings as originally filed, the lead line for reference number "22" has been changed to have an arrow.

In light of the proposed drawing amendment, it is therefore submitted that the objection to the drawings as originally filed has been overcome, and withdrawal of the objection to the drawings is respectfully requested.

Paragraphs 2 and 3 of the Office Action

Claims 1-2, 4-5, 8 and 10-11 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Number 5,817,041 to Bader.

In regard to claim 1, it is submitted that the Bader reference does not disclose, teach or suggest "each support member having an extension portion and a foot portion, said extension portion extending from said foot portion at an angle such that said extension portion is adapted for positioning in front of a lateral malleolus of the user, said foot portion of each of said support members being positioned in a spaced relationship and below the foot of the user to inhibit the foot of the user from contacting the supporting surface". The Bader reference teaches a rigid lower-limb orthotic that fails to teach each of the support members having a foot portion extending below the foot of the user and are positioned in a spaced

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relationship to each other so that the foot portion of each of aid support members inhibits contact of the foot of the user with the support surface as claimed by the applicant and thereby remove any weight bearing on the foot and ankle of the user. Further, the Bader reference shows the supporting members extending in line with the fibula of the leg and therefore fails to meet the requirement of the extension portion extending at an angle to the foot portion so that the extension portion passes in front of the lateral malleolus of the user. Therefore, it is submitted that the Bader reference would not lead one to anticipate the combination of features as claimed by the applicant.

Claims 2, 4, 5, 10 and 11 are dependent upon claim 1, particularly as amended, and therefore incorporate the requirements of claim 1. Thus, claims 2, 4, 5, 10 and 11 are also believed to be allowable over the cited reference.

Claim 8 has been cancelled.

Withdrawal of the §102(b) rejection of claims 1-2, 4-5, 8 and 10-11 is therefore respectfully requested.

Paragraph 4 of the Office Action

Claims 1, 3-4, 6-7, 9 and 11 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Number 3,805,773 to Sichau.

In regard to claim 1, it is submitted that the Sichau reference does not disclose, teach or suggest "each support member having an extension portion and a foot portion, said extension portion extending from said foot portion at an angle such that said extension portion is adapted for positioning in front of a lateral malleolus of the user, said foot portion of each of said support members being positioned in a spaced relationship and below the foot of the user to inhibit the foot of the user from contacting the supporting surface". The Sichau reference teaches a training assist brace that fails to teach each of the support members having a foot portion extending below the foot of the user and are positioned in a spaced

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relationship to each other so that the foot portion of each of aid support members inhibits contact of the foot of the user with the support surface, and the extension portion extending at an angle to the foot portion so that the extension portion passes in front of the lateral malleolus of the user as claimed by the applicant and thereby removing any weight bearing on the foot and ankle of the user. Therefore, it is submitted that the Sichau reference would not lead one to anticipate the combination of features as claimed by the applicant.

Claims 3, 4, 6, 7, 9 and 11 are dependent upon claim 1, particularly as amended, and therefore incorporate the requirements of claim 1. Thus, claims 3, 4, 6, 7, 9 and 11 are also believed to be allowable over the cited reference.

Withdrawal of the §102(b) rejection of claims 1, 3-4, 6-7, 9 and 11 is therefore respectfully requested.

Paragraphs 5 and 6 of the Office Action

Claim 9 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Bader in view of U.S. Patent Number 3,805,773 to Sichau.

In regard to claim 1, it is submitted that the combination of Bader with Sichau is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the references do not disclose, teach or suggest "each support member having an extension portion and a foot portion, said extension portion extending from said foot portion at an angle such that said extension portion is adapted for positioning in front of a lateral malleolus of the user, said foot portion of each of said support members being positioned in a spaced relationship and below the foot of the user to inhibit the foot of the user from contacting the supporting surface". As discussed above, the Bader and Sichau references fail to teach each of the support members having a foot portion extending below the foot of the user and are positioned in a spaced relationship to

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each other so that the foot portion of each of aid support members inhibits contact of the foot of the user with the support surface, and the extension portion extending at an angle to the foot portion so that the extension portion passes in front of the lateral malleolus of the user as claimed by the applicant and thereby removing any weight bearing on the foot and ankle of the user. It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious--there must be a motivation provided by the prior art, and that motivation is totally lacking in the reference.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape *** since *this is within the capabilities of such a person.*" Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980)
(emphasis in original).

Therefore, it is submitted that the combination of the Bader reference with Sichau reference would not lead one to the combination of features as claimed by the applicant.

Claim 9 is dependent upon claim 1, particularly as amended, and therefore incorporates the requirements of claim 1. Thus, claim 9 is also believed to be allowable over the cited reference.

Withdrawal of the §103(a) rejection of claim 9 is therefore respectfully requested.

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Paragraph 7 of the Office Action

Claim 12 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Bader in view of U.S. Patent Number 5,605,535 to Lepage.

In regard to claim 1, it is submitted that the combination of Bader with Lepage is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the references do not disclose, teach or suggest "each support member having an extension portion and a foot portion, said extension portion extending from said foot portion at an angle such that said extension portion is adapted for positioning in front of a lateral malleolus of the user, said foot portion of each of said support members being positioned in a spaced relationship and below the foot of the user to inhibit the foot of the user from contacting the supporting surface". As discussed above, the Bader reference fails to teach each of the support members having a foot portion extending below the foot of the user and are positioned in a spaced relationship to each other so that the foot portion of each of aid support members inhibits contact of the foot of the user with the support surface, and the extension portion extending at an angle to the foot portion so that the extension portion passes in front of the lateral malleolus of the user as claimed by the applicant and thereby removing any weight bearing on the foot and ankle of the user. The Lepage reference teaches an ankle positioning splint that fails to teach each of the support members having a foot portion extending below the foot of the user and are positioned in a spaced relationship to each other so that the foot portion of each of aid support members inhibits contact of the foot of the user with the support surface, and the extension portion extending at an angle to the foot portion so that the extension portion passes in front of the lateral malleolus of the user as claimed by the applicant and thereby removing any weight bearing on the foot and ankle of the user. It is also submitted that the mere fact that one may argue that the prior art is capable

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of being modified to achieve a claimed structure does not by itself make the claimed structure obvious--there must be a motivation provided by the prior art, and that motivation is totally lacking in the reference.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape *** since *this is within the capabilities of such a person.*" Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980)

(emphasis in original).

Therefore, it is submitted that the combination of the Bader reference with Sichau reference would not lead one to the combination of features as claimed by the applicant.

Claim 12 is dependent upon claim 1, particularly as amended, and therefore incorporates the requirements of claim 1. Thus, claim 12 is also believed to be allowable over the cited reference.

Withdrawal of the §103(a) rejection of claim 12 is therefore respectfully requested.

New Claims

New claim 13 has been added to vary the scope of the claims and clarify the present invention. All limitations are supported by the original disclosure including the specification, drawings and original claims. Claim 13 incorporates limitations from amended claim 1 that are believed to be in condition for allowance as discussed above in reference to the Bader, Sichau and Lepage references. Therefore, no new matter has been added. The new

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claim is believed to be allowable.

CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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By 

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